

REMARKS-General

1. Upon review of the original specification and in light of the observation of the Examiner noted in the above Office Action, the applicant has submitted an amended specification which is deemed to more clearly and distinctly describe the subject matter of the instant invention, and which provides full antecedent basis to the newly drafted claims. No new matter has been included in the amended specification.

2. The amended independent claims 1 and 22 incorporate all structural limitations of the original claims 1 and 22 and include further limitations previously brought forth in the disclosure. No new matter has been included. All amended claims 1-2, 10-16, 18-19, and 22 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Rejection of the Specification under 35USC112

3. The applicant submits that the amended specification describes the subject matter of the instant invention with sufficient clarity and detail to overcome the rejection thereof under 35USC112.

Response to Rejection of Claims 14, 16, and 22 under 35USC112

4. The applicant submits that the amended claims 14, 16, and 22 particularly point out and distinctly claim the subject matter of the instant invention, as pursuant to 35USC112.

Regarding to Rejection of Claims 1-9, 14, 15, 22, 23, 26 and 27 under 35USC102

5. Pursuant to 35 U.S.C. 102, "a person shall be entitled to a patent unless:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

6. In view of 35 U.S.C. 102(b), it is apparent that a person shall not be entitled to a patent when his or her invention was patent in this country more than one year prior to the date of the application for patent in the United States.

7. However, the Jalili patent and the instant invention are not the same invention according to the fact that the independent claims 1 and 16 of the Jalili patent does not read upon the instant invention and the independent claims 1 and 22 of the instant invention does not read upon the Jalili patent too. Apparently, the instant invention, which discloses a mobile payment system and method, should not be the same invention as the Jalili patent which discloses a method of completing a purchasing utilizing a first electronic network and a second electronic network.

8. Jalili fails to anticipate the distinctive features of providing a mobile payment method which comprises the steps of (i) receiving a payment request in an operation center from a registered merchant through a communication network; (ii) requesting the registered merchant, through the communication network, to inform a customer ID of a customer, who is a registered member of the operation center, and a transaction amount to be paid by the customer to the registered merchant; (iii) verifying a merchant ID of the registered merchant by the operation center; (iv) confirming the payment request by the operation center by notifying the customer and requesting for verification; (v) requesting the customer to verify the payment transaction by confirming the transaction amount and digitally signing back a message of the customer registered in the operation center; and (vi) confirming with the registered merchant whether the payment request is issued (as claimed in claim 1).

9. In addition, Jalili merely teaches (column 2, lines 41-48) the customer is identified by the telephone system's CallerID function plus a personal identification number (PIN) and/or other registered information for extra security. If the customer's telephone number on file with the processing center does not match the telephone number detected by CallerID, an operator will ask the customer for further identifying information. Therefore, Jalili fails to anticipate the customer digitally signs back a message by using strong public key cryptography to the operation center for verification (as claimed in claim 1). In other words, the instant invention provides a much better security than just a CallerID used by Jalili patent.

10. The applicant respectfully submits that Jalili fails neither suggest nor anticipate the following distinctive features as claimed in the claims 1-9, 14, 15, 22, 23, 26 and 27 as amended above:

(vii) failing to anticipate the elements of the method claim 1 of the instant invention including the steps of (a) receiving a payment request ...; (b) requesting the registered merchant...; (c) verifying ...; (d) confirming ...; (e) requesting ...; and (f) confirming ...; moreover, a mere description of first and second electronic networks being not equivalent to the communication system in the mobile payment method as claimed in the instant invention;

(viii) indicating to the registered merchant by the customer that the customer prefers to settle a payment through a mobile payment system when the customer decides to purchase one or more products from the registered merchant (as claimed in claim 2);

(ix) requesting the customer ID of the customer and the transaction amount by the operation center through a communication terminal (as claimed in claims 3 and 4);

(x) requesting the customer to confirm the transaction amount and to digitally sign the message of the customer and verifying the transaction amount and digitally signing the message by the customer (as claimed in claim 15); and

(xi) failing to anticipate nor suggest any communication device, which is carried by the customer, connecting with the operation center for receiving confirmation message from the operation center to verify a payment amount requested by the registered merchant for at least a product purchased by the customer from the registered merchant, by providing a digitally signed message of the customer in the communication device for transmitting to the operation center (as claimed in claim 22).

Response to Rejection of Claims 10-13, 16-21, 24, 25, 28, and 29 under 35USC103

11. The Examiner rejected claims 10-13, 16-21, 24, 25, 28, and 29 over Jalili in view of Nessett.

12. The Examiner appears to reason that since Jalili teaches a method of completing a purchasing utilizing a first electronic network and a second electronic network, it would have been obvious to one skilled in the art to modify the purchasing method by using WAP phone. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), *In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

13. In the present case, there is no such suggestion. Jalili and Nessett perform very different types of purchasing method.

14. Jalili merely anticipates (column 2, lines 40-41) the customer accesses the processing center using a touch-tone phone or a modem. However, Jalili fails to anticipate the communication network is a WAP secured transaction layer cellular network. In other words, the mobile payment method of the instant invention is processed through the WAP phone as a wireless communication media. Therefore, the customer is able to use the personal WAP phone as the conventional credit card or debit card for purchasing anywhere without passing any personal confidential information such as credit card numbers, customer's name and signature to the merchant.

15. Nessett discloses a method for identifying internal network services wherein the network devices and routers includes network device that can interact with network

system based on standards proposed by Wireless Application Protocol (WAP) Forum without any mention of any mobile payment system by using a WAP phone to send a notification message to indicate the payment request.

16. In any case, even combining Jalili and Nessett would not provide the invention as claimed -- a clear indicia of nonobviousness. *Ex parte Schwartz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992), ("Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed."). That is, modifying Jalili with Nessett, as proposed by the Examiner, would not provide the above distinctive features (i) to (xi) as claimed in the instant invention.

17. Applicant believes that neither Jalili nor Nessett, separately or in combination, suggest or make any mention whatsoever of using a WAP phone as a mobile communication media to identify and verify the customer through a mobile payment system as recited in claims 10-13, 16-21, 24, 25, 28, and 29.

18. Applicant believes that for all of the foregoing reasons, all of the claims are in condition for allowance and such action is respectfully requested.

The Cited but Non-Applied References

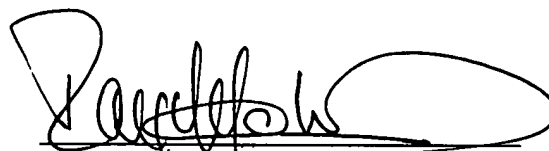
19. The cited but not relied upon references have been studied and are greatly appreciated, but are deemed to be less relevant than the relied upon references.

20. This amount is believed to be correct; however, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 502111.

21. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the objection are requested. Allowance of claims 1-29 at an early date is solicited.

22. Should the Examiner believe that anything further is needed in order to place the application in condition for allowance, he is requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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CERTIFICATE OF MAILING

I hereby certify that this corresponding is being deposited with the United States Postal Service by First Class Mail, with sufficient postage, in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date:

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Person Signing: Raymond Y. Chan

